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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,694	04/16/2001	John J. Donnelly	18972PCA	5738
7590	07/27/2005		EXAMINER	
Merck & Co., Inc. Patent Department P.O. Box 2000 - RY60-30 Rahway, NJ 07065-0907			KETTER, JAMES S	
			ART UNIT	PAPER NUMBER
				1636

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/835,694	DONNELLY ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	James S. Ketter	1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 13 December 2004.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-3,7-10 and 17 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-3,7-10 and 17 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/13/2004.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

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Claims 1-3, 7-10 and 17 are pending. Claims 4-6, 11-16 and 18-25 were canceled. No claim is allowed.

Receipt of a proper declaration and an IDS is acknowledged.

The application filed on March 18, 1993 should be 08/032,383 and not 08/461,268. Continuity is found through application 08/089,985. Application 08/032,383 is a CON of PCT/US94/02751 and not of application 08/089,985.

Claims 1-3, 7-10 and 17 as drawn to the V1J construct are given priority to application 08/032,383 with a filing date of March 18, 2003. Claims 1-3, 7-10 and 17 as drawn to the V1Jns construct are given priority to PCT/US94/02751 with a filing date of March 13, 1994.

Claims 1 and 3 are objected to because of the following informalities:

Claims 1 and 3 are in part drawn to an invention that is independent or distinct from the invention originally claimed for the following reasons: The applicant was required to select a plasmid backbone in the restriction requirement, but all the plasmid backbones are still present in the instant claims. The action on the merits was only drawn to V1J and V1Jns plasmid backbones.

Appropriate correction is required.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 7-10 stand rejected under 35 U.S.C. 102(b) as being anticipated by Montgomery et al (DNA and Cell Biology, 1993, volume 2, issue 9, pages 777-783), for reasons of record set forth in the previous Office Action.

The submission of the petition under 37 CFR 1.78(a)(3) on 13 December 2005 is noted. The petition has been forwarded to the Office of Petitions for consideration in due course. However, until such time as the petition is granted, the priority claim cannot be perfected, and the instant rejection must stand.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 7, 8, 10, 11 and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al (DNA and Cell Biology, 1993, volume 2, issue 9, pages 777-783) in view of Felgner et al (US 5,580,859), for reasons of record set forth in the previous Office Action.

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Claims 1-3, 7-10 and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al (DNA and Cell Biology, 1993, volume 2, issue 9, pages 777-783) in view of Robinson et al (US 5,643,578), for reasons of record set forth in the previous Office Action.

As set forth for the rejection under §102(b) above, the submission of the petition under 37 CFR 1.78(a)(3) on 13 December 2005 is noted. The petition has been forwarded to the Office of Petitions for consideration in due course. However, until such time as the petition is granted, the priority claim cannot be perfected, and the instant rejection must stand.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner with respect to the examination on the merits should be directed to James Ketter whose telephone number is (571) 272-0770. The Examiner normally can be reached on M-F (9:00-6:30), with alternate Fridays off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Remy Yucel, can be reached at (571) 272-0781.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables

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applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Jsk  
March 3, 2005



JAMES KETTER  
PRIMARY EXAMINER